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Docket No. 59131/JPW/AJM



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Taka-Aki Sato
Serial No.: 09/327,750 Examiner: J.E. Goldberg
Filed : June 7, 1999 Group Art Unit: 1655
For : GENE ENCODING NADE, P75^{NTR}-ASSOCIATED CELL DEATH
EXECUTOR AND USES THEREOF

1185 Avenue of the Americas
New York, New York 10036
January 10, 2002

Hon. Commissioner for Patents
Washington, D.C. 20231

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COMMUNICATION IN RESPONSE TO
DECEMBER 10, 2001 RESTRICTION REQUIREMENT

This Communication is submitted in response to the Restriction Requirement issued December 10, 2001 in connection with the above-identified application. A response to the December 10, 2001 Restriction Requirement is due January 10, 2002. Accordingly, this Communication is being timely filed.

Claims 1-4, 8-23, 29, 55, 56 and 131-133 are pending in the subject application. In the Restriction Requirement, the Examiner required restriction to one of the following allegedly distinct inventions as follows:

- I. Claims 1-4, 8-23, and 132, drawn to an isolated nucleic acid molecule encoding a polypeptide capable of binding to a p75^{NTR} receptor, vectors, host cells, and a method of producing the polypeptide;

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II. Claim 29, drawn to a polypeptide capable of binding to a p75^{NTR} receptor;

III. Claims 55 and 56, drawn to a method for identifying compounds which are capable of inhibiting binding between a p75^{NTR} receptor and a polypeptide;

IV. Claim 131, drawn to antibodies; and

V. Claim 133, drawn to a method of identifying an apoptosis-inducing compound.

In response, applicant hereby elects Group I, claims 1-4, 8-23 and 132, with traverse for prosecution at this time.

REMARKS

In the December 10, 2001 Restriction Requirement, the Examiner alleged that the inventions are distinct, each from the other, because they are unrelated. Specifically, the Examiner asserted that because the inventions of Groups I-V set forth in the Restriction Requirement have acquired a separate status in the art as shown by their different classification, requirement for independent searches, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant, however, respectfully requests that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent

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and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I-V are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. The inventions of Groups I-V are drawn to methods and compositions of matter relating to a p75^{NTR} receptor. Applicant therefore maintains that the Groups are not independent and restriction is not proper.

Furthermore, under M.P.E.P. §803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicant respectfully submits that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Group I would necessarily turn up the prior art relevant to the claims of Groups II-V and vice versa. Since there is no burden on the Examiner to examine Groups I-V together in the subject application, the Examiner must examine the entire application on the merits.

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In view of the foregoing, applicant maintains that restriction is not proper under 35 U.S.C. §121, and respectfully requests that the Examiner reconsider and withdraw the requirement for restriction.

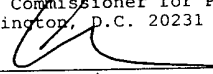
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicant
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:
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Alan J. Morrison
Reg. No. 37,399

1/10/02 Date